

REMARKS

Claims 1-5 are active and pending in this application. Claims 1-4 stand rejected under 35 USC §103 as unpatentable over Kim (USP 6,214,645) in view of Ferguson et al. (USP 5,394,609). Claim 5 stands rejected under 35 USC § 102 as anticipated by Ferguson et al.

In this Amendment, claim 4 has been amended to improve wording but its scope is not narrowed for any reason relating to patentability. No new matter is introduced. Claim 5 has been canceled, thus obviating the 35 USC § 102 rejection.

Applicants have submitted herewith proposed drawing amendments which add a "Prior Art" label to Figures 8A, 8B, 8C, 8D and 9.

In rejecting claims 1-4, the Examiner asserts that Kim discloses the invention substantially as recited in claim 1 but admits that Kim does not teach a mini-card. The Examiner contends that Ferguson et al. teach such a mini-card and concludes it would have been obvious to combine the references because doing so would "provide Kim with a more compact system."

Applicants respectfully disagree with the characterization of the device disclosed by Kim. In particular, Kim discloses a single substrate 10 on which multiple BGA packages can be mounted. In direct contrast to the disclosure of Kim, claim 1 recites an array of individual substrates. Ferguson et al. discloses multiple, physically distinct substrates as well which are arranged together within a holder. Moreover, Applicants submit that Kim fails to disclose a step of dividing the substrate array to provide encased individual substrates. This is so because Kim's single substrate 10 does not correspond to the substrate array of the claimed invention, though Kim discloses a step of cutting a

BGA package from the substrate 10 along cutting line 19'. Therefore, the combination of Kim and Ferguson et al. does not disclose or suggest every feature recited in claim 1. Accordingly, this combination of references does not provide the factual basis to support a *prima facie* case of obviousness under 35 USC §103. Reconsideration and withdrawal of the rejection under 35 USC §103 of claims 1-4 are respectfully requested.

Applicants also urge that the Examiner has not satisfied the burden of explaining why one of ordinary skill would have realistically been impelled to make the proposed combination. In particular, the purported benefit gained from Ferguson et al. is that the BGA devices of Kim would be smaller if the teachings of Ferguson et al. were used. While none of the references explicitly discuss specific sizes of circuitry involved, the Examiner's basis for combining the references appears to be factually incorrect if Kim is assumed to relate to conventionally-sized BGA packages and Ferguson et al. is assumed to relate to conventionally-size mini-cards. Applicants urge that putting BGA packages, which are typically smaller than mini-cards, within a mini-card housing would not make a more compact BGA package as contended by the Examiner. To the contrary, the hypothetical mini-card resulting from such a combination would be less compact than the BGA package taught by Kim because it would now be the size of a mini-card. Thus, there does not appear to be any realistic motivation why one of ordinary skill would have been impelled to modify the BGA devices of Kim to form the mini-cards taught by Ferguson et al. Therefore, Applicants urge that the burden of establishing a *prima facie* case of obviousness under 35 USC 103 has not been discharged and respectfully request reconsideration and withdrawal of the rejection under 35 USC 103 of claims 1-4.

SUMMARY

In view of the above remarks and amendments, Applicants believe that claims 1-4 are in condition for allowance and passage of this case to issue is respectfully requested.

To the extent necessary, a petition for an extension of time under 37 C.F.R. 1.136 is hereby made. Please charge any shortage in fees due in connection with the filing of this paper, including extension of time fees, to Deposit Account 500417 and please credit any excess fees to such deposit account.

Respectfully submitted,

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